UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,135	08/27/2003	Neil Leonard Shipp	MS#303737.01 (5224)	4780

			EXAMINER
38779	7590	02/21/2006	DAYE, CHELCIE L

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ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/649,135	SHIPP, NEIL LEONARD
	Examiner	Art Unit	
	Chelcie Daye	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *6/3/2005*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is issued in response to Application filed on August 27, 2003.

2.   Claims 1-21 are pending.

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on June 3, 2005 was filed

after the mailing date of the application on August 27, 2003. The submission is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement is being considered by the examiner.

Claim Objections

4.   Claims 6,13, and 20 are objected to because of the following informalities:

"MAPI". The use of acronyms, are not permissible within the claim language.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter "greater

than 256 characters", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is insufficient details regarding the limitation "greater than 256 characters", which is not found within the specification of the application. Examiner is unsure how an 8-bit character can be greater than 256 characters, when at most an 8-bit character, at most can be 256 characters. In order to further prosecution, examiner interprets the limitation to mean at least 256 characters using an 8-bit character width.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1,5-8,12-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (US Patent No. 5,966,714) filed April 30, 1996, in view of Chin (US Patent Application No. 20010029455) filed April 2, 2001 and further in view of "Microsoft Internet Explorer 6 Public Preview Release Notes", Published 2001, referred to hereinafter as "IE6".

Regarding Claims 1,7,8,14,15, and 21, Huang discloses a method for searching an offline address book, the method comprising:

accepting a first textual information from the offline address book in a format (columns 3-4, lines 66-67 and 1-12, respectively, Huang)[1],

accepting a second textual information (Fig.1d; column 5, lines 54-57, Huang) in a native character set representation (column 14, lines 52-57, Huang)[2]. However, Huang does not explicitly disclose converting the first textual information to a corresponding character set; comparing the converted first textual information to the second textual information; and posting the converted textual information to an output mechanism. On the other hand, Chin discloses converting the first textual information ([0107], lines 1-9, Chin) to a corresponding character set ([0134], lines 4-7, Chin)[3]; comparing the converted first textual information to the second textual information ([0043], lines 7-13, Chin); and posting the converted textual information to an output mechanism ([0125], lines 1-10, Chin)[4]. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Chin's teachings of converting into the Huang system. A skilled artisan would have been motivated to do so in order to change data from one format to another, to better accommodate the desired users

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[1] Examiner Notes: "Automatically generating, storing, and maintaining" corresponds to the act of accepting and the first textual information is represented by the email addresses that the address book contains.

[2] Examiner Notes: "Data formats" correspond to character set representation.

[3] Examiner Notes: The input text is converted to the output text and the output text can be represented as the Unicode character string which corresponds to character set.

[4] Examiner Notes: Since the invention is done online the obvious output would have to be through either a monitor or a printer which is an output mechanism.

needs. As a result, this enhances responsiveness to requests and therefore produces an easy-to-use method for generating addresses. However, Huang in view of Chin, do not explicitly disclose the format allowing for representation of greater than 256 characters using 8-bit character widths. On the other hand, IE6 discloses the format allowing for representation of greater than 256 characters using 8-bit character widths (pgs.6-7, lines 49-55 and 1-8, IE6)[5]. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate IE6's teaching of formatting into the Huang in view of Chin system. A skilled artisan would have been motivated to combine in order to allow for easier internationalization, which would attract a broader customer base. The Huang in view of Chin system as cited uses a Unicode in order to handle output in all supported language pairs ([0134], lines 7, Chin), which further shows the need and convenience for using UTF-8. IE6 discusses transmitting non-English addresses to servers, and UTF is a form of Unicode, which is a well-known and highly used form of converting/translating characters. Also, Internet Explorer is known to have "address books" as discussed in IE6 (pg.7, 3rd full paragraph), therefore making it evident to not only incorporate UTF-8 into the URL's and queries, but also into the addresses. Incorporating UTF-8 provides for support of extended ASCII characters as well as the translation of international character sets. As a result, UTF-8 is a logical choice to provide the means for users to encode text of documents, they want to store in computers.

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[5] Examiner Notes: UTF-8 stands for "8-bit Unicode Transformation Format". Also, known to one of

Regarding Claims 2,9, and 16, the combination of Huang in view of Chin, and further in view of IE6, disclose the method wherein the underlying file format remains unaltered ([0127], lines 4-12, Chin)[6].

Regarding Claims 3,10, and 17, the combination of Huang in view of Chin, and further in view of IE6, disclose the method wherein the offline address book's underlying representation remains unaltered ([0135], lines14-20, Chin).

Regarding Claims 4,11, and 18 the combination of Huang in view of Chin, and further in view of IE6, disclose the method wherein low level string comparisons with the offline address book are able to be performed ([0234], lines 4-11, Chin)[7].

Regarding Claims 5,12, and 19, the combination of Huang in view of Chin, and further in view of IE6, disclose the method wherein the format is UTF-8 (pg.6, lines 49-53, IE6).

Regarding Claims 6,13, and 20, the combination of Huang in view of Chin, and further in view of IE6, disclose the method wherein the offline address book

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ordinary skill in the art, 8-bit equals 256 characters.

[6] Examiner Notes: The processing of the data has not changed just because of the search, therefore the format of the file itself is unaltered.

[7] Examiner Notes: The "second level" corresponds to low level.

is MAPI compliant (column 4, lines 30-35, Huang).

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye
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Technology Center 2100
February 15, 2006